

REMARKS

Claims 1-42 remain in this application. Claims 1, 19, and 26-27 are amended to recite “gathering a set of communication information relating to a type of the predetermined event from said communication at said selected location in response to said detection of the occurrence of said type of the predetermined event.” These features are supported at least on page 14, lines 14-15 of the current specification. No new matter is added as a result of the above amendments. Reconsideration of this application in light of the above amendments and the following remarks is requested.

Rejections Under 35 U.S.C. §103(a), Claims 1-3, 5-8, 12, 14-15, 17, 18-20, 22-24, and 26

Claims 1-3, 5-8, 12, 14-15, 17, 18-20, 22-24, and 26 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sjoblom (U.S. Publication No. 2002/0150096) in view of newly cited reference by Hippelainen (U.S. Publication No. 2002/0078384). This rejection is respectfully traversed.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following, mutually exclusive, reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The Sjoblom and Hippelainen references cannot be applied to reject claims 1, 19, and 26 under 35 U.S.C. § 103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. Neither Sjoblom nor Hippelainen discloses or suggests “gathering a set of communication information relating to a type of the predetermined event from said communication at said selected location in response to said detection of the occurrence of said type of the predetermined event,” as is claimed in claims 1, 19, and 26 it is impossible to render the subject matter of claims 1-3, 5-8, 12, 14-15, 17, 18-20, 22-24, and 26 as a whole obvious, and the explicit terms of the statute cannot be met.

The examiner admits that Sjoblom does not disclose such features, but alleges that Hippelainen discloses these features in paragraphs 60-61, which read as follows:

According to FIG. 3, an initial interception request is issued from the LEA to the LIG. In fact, the LEA passes a lawful authorization to the network operator, access provider or service provider. The network operator, access provider or service provider determines the relevant target identities from the information given in the lawful authorization. Then, the network operator, access provider or service provider commands an interception control unit, used for controlling the interception functions of the LIGs, to provide a corresponding interception information to the LIG of the relevant target identity. The interception control unit can be arranged in the LEA (as in the case of FIG. 3) or in a separate network element.

Subsequently, the interception control unit transmits the required LIG settings via the packet network to the corresponding LIG. In response to the receipt of the LIG settings, the LIG performs a packet interception and duplicates those packets which are to be intercepted based on their header information. Then, the intercepted packets are encrypted and fake packets are generated and added to the intercepted packets. These encrypted and blurred data packets are transmitted via corresponding interworking units (IWU) through the ATM WAN to the LIG. Due to the encryption processing, a secure tunnel is established, although the intercepted data packets are transmitted via a normal channel of the packet network. (Emphasis added)

Paragraphs 60-61, Hippelainen.

Fig. 3 of Hippelainen is shown below:

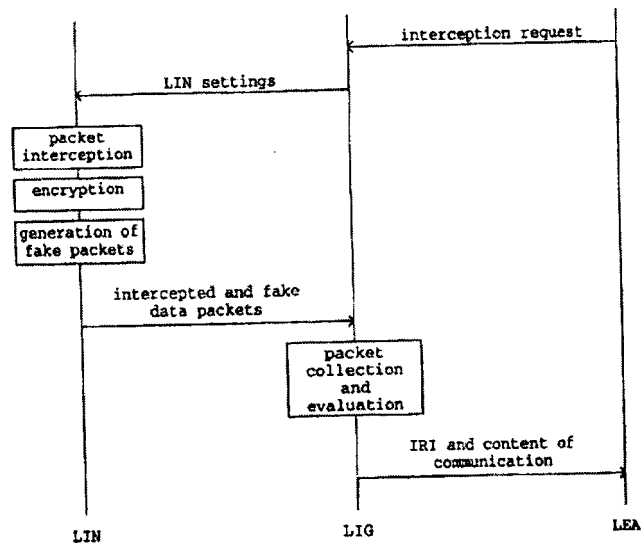


Fig. 3

In the above section and in Fig. 3, Hippelainen discloses that the lawful interception node (LIN) intercepts the packet and duplicates the intercepted packet based on the header information. The LIN then encrypts the intercepted packet and adds generated fake packets to the intercepted packet. Contrary to the examiner's allegation, the LIN gathers all the information from the packets each time they are intercepted by duplicating them. Hippelainen does not gather a set of communication information from the packet relating to the type of event detected.

Instead, Hippelainen duplicates all the information from the packet and encrypts the entire intercepted packet. This is different from the presently claimed features in that Hippelainen gathers all the information available from the packet instead of gathering a set of information that is related to the type of detected event. For example, if the detected event type is call signaling, the information in Table I relating to call signalling is gathered. If the detected event type is establishment or release of packet mode communication path, the information in Table II relating to the establishment or release of packet mode communication is gathered. Hippelainen does not disclose such features as recited in amended claims 1, 19, and 26.

Furthermore, the examiner alleges that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Sjoblom to include gathering a set of communication information relating to the type of detected event such as a

transmission of a packet as taught by Hippelainen, because one is motivated as such in order to intercept the relevant target identify packets to make available results of interception relating to a specific identifies to a Law Enforcement Agency. Applicants respectfully disagree.

As discussed above, Hippelainen is only interested in duplication all the information from the packets that are identified in the header information. Hippelainen does not gather a set of information from the intercepted packet relating to the type of detected event. This is because Hippelainen is only interested in “a packet reading means 11 where the header of the extracted data packets is read and analyzed as to whether the data packet should be intercepted or not.” (Paragraph 66). Hippelainen is not interested in gathering a set of communication information that relates to the type of detected event. Therefore, one of ordinary skill in the art would not have been led to combine the disclosures of Sjoblom and Hippelainen to reach the features of claims 1, 19, and 26.

Accordingly, for at least this reason, Sjoblom and Hippelainen are insufficient to provide a *prima facie* case of obviousness with regard to claims 1-3, 5-8, 12, 14-15, 17, 18-20, 22-24, and 26. For the reasons described above, the examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. The Combination of References is Improper

There is still another reason why the Sjoblom and Hippelainen references cannot be applied to reject claims 1-3, 5-8, 12, 14-15, 17, 18-20, 22-24, and 26 under 35 U.S.C. § 103(a).

§ 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant’s disclosure, refrain from using hindsight, and consider the subject matter claimed ‘as a whole’.

Here, neither Sjoblom nor Hippelainen discloses, or even suggests, the desirability of the combination since neither discloses “gathering a set of communication information relating to a type of the predetermined event from said communication at said selected location in response to said detection of the occurrence of said type of the predetermined event” as is claimed in

claims 1, 19, and 26. As discussed above, Hippelainen merely duplicates all the information in the packets that are identified in the header information. Hippelainen does not gather a set of communication information from the packet relating to the type of detected event.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claims 1-3, 5-8, 12, 14-15, 17, 18-20, 22-24, and 26. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

For the reasons described above, Sjoblom and Hippelainen do not render the claims *prima facie obvious*, and the rejections of claims 1-3, 5-8, 12, 14-15, 17, 18-20, 22-24, and 26 under 35 U.S.C. §103 should be withdrawn.

Rejections Under 35 U.S.C. §103(a), Claims 9, 11, 13, 25, and 27-42

Claims 9, 11, 13, 25, and 27-42 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sjoblom in view of Hippelainen and further in view of Prieur (U.S. Patent No. 6,470,075). This rejection is respectfully traversed.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following, mutually exclusive, reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The Sjoblom and Hippelainen references cannot be applied to reject claims 9, 11, 13, 25, and 27-42 under 35 U.S.C. § 103. As discussed above in arguments presented for claims 1, 19, and 26, neither Sjoblom nor Hippelainen discloses or suggests “gathering a set of communication information relating to a type of the predetermined event from said communication at said selected location in response to said detection of the occurrence of said type of the predetermined event,” as is claimed in claims 1, 19, and 26. Prieur also does not disclose such features

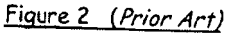
The examiner alleges that Prieur discloses these features at column 3, line 60 to column 4, line 7, column 4, lines 54-56, and column 5, line 49 to column 6, line 2, which read as follows:

The access sub-function 12, shown in Fig. 1, is typically embodied as one or more Intercept Access Point (IAPs) 14, connected to the appropriate nodes of the cellular telecommunication network 10, as shown in Fig. 2, or to the PSTN nodes (not shown). Typically, these nodes may be mobile switching centers (MSCs) 16, as shown in Fig. 2, since MSCs 16 are the core of the cellular telecommunication network, and voice and data communication always go through at least one MSC where they are most likely to be intercepted. The IAP is typically provided as a node within the cellular telecommunication network 10, or the PSTN 11, where the communications of a monitored subscriber are accessed. Alternatively, the IAP may be co-located with the MSC 16.

Column 3, line 60 to column 4, line 7, Prieur.

Continuing to refer to Fig. 2, once the call content and the call identification information are intercepted by the IAP 14, they are typically delivered, through the delivery function 18 to the Law Enforcement Agency 30. As stated, the delivery function 18 may also be provided as a software tool implemented as part of the MSC 16 or the IAP 14. Alternatively, the delivery function may comprise dedicated hardware circuitry for delivering the intercepted information to the LEA 30. As described in the foregoing, the delivery function 18 is associated with the delivery network comprising call content channel 32 for delivering the call content information, such as the voice and data information, and the call data channel 34 for delivering the call identifying information.

Fig. 2 of Prieur is shown below:



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intercepted communication and the call-identifying information of the monitored subscribers for a particular LEA (column 4, lines 20-24).

However, nowhere in the reference does Prieur mention that “a SAP that gathers a set of communication information relating to a type of the event from said intercepted communication upon the detection of the type of the event,” as recited in claim 27. To the contrary, Prieur specifically discloses, at column 4, lines 39-43, that “the collection sub-function 20 is under the responsibility of the LEAs.” Therefore, it is the LEAs that collect the information sent by the cellular operators from the delivery sub-function 18.” Thus, instead of a SAP that gathers the communication information, Prieur discloses that the information is collected by the LEAs. Since Prieur does not disclose a SAP that gathers communication information, Prieur does not and would not disclose a SAP that gathers a different type of communication information relating to a type of the event. Therefore, Prieur also does not disclose or suggest the features of claim 27.

In addition, the examiner alleges that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Sjoblom to include the features of performing the functionalities as taught by Prieur in order for the LEAs to find potentially incriminating information relating to the monitored subscribers in real time without prolonged delay. Applicants respectfully disagree.

Sjoblom merely discloses gathering all necessary interception related information (intercepted data) from the communication and generating a data packet. There is no mention of a type of the event, let alone gathering a set of communication information relating to a type of the detected event. Prieur, on the other hand, merely discloses a collector module within a LEA that collects intercepted information, not a SAP that gathers communication information. Therefore, Prieur does not and would not disclose a SAP that gathers a set of communication information relating to a type of detected event. One of ordinary skill in the art would not have been led to modify the teachings of Sjoblom to include Prieur’s collector module, because Prieur’s collector module for collecting communication information is within a LEA, not a SAP. In addition, neither reference mentions gathering a set of communication information relating to an event type. Therefore, one of ordinary skill in the art would not have been led to include the feature of claim 27, as alleged by the examiner.

Accordingly, for at least this reason, Sjoblom, Hippelainen, and Prieur, either alone or in combination, are insufficient to provide a *prima facie* case of obviousness with regard to claims 9, 11, 13, 25, and 27-42. For the reasons described above, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. The Combination of References is Improper

There is still another reason why the Sjoblom, Hippelainen, and Prieur references cannot be applied to reject claims 9, 11, 13, 25, and 27-42 under 35 U.S.C. § 103(a).

Here, Sjoblom, Hippelainen, and Prieur also fail to disclose, or suggest, the desirability of the combination since neither discloses "a surveillance access point (SAP) operable to communicate with said node, wherein said SAP gathers a set of communication information relating to a type of the event from said intercepted communication upon the detection of the type of the event" as is claimed in claims 1, 19, 26, and 27 from which claims 9, 11, 13, 25, and 28-42 depend. As discussed above, Hippelainen merely duplicates all the information in the packets that are identified in the header information. Hippelainen does not gather a set of communication information relating to a type of detected event. Prieur merely discloses a LEA, not a SAP, that gathers all intercepted information.

Thus, it is clear that none of the references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection. In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claims 9, 11, 13, 25, and 27-42. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.


For the reasons described above, Sjoblom, Hippelainen, and Prieur, either alone or in combination, do not render the claims *prima facie obvious*, and the rejections of claims 9, 11, 13, 25, and 27-42 under 35 U.S.C. §103 should be withdrawn.

Conclusion

It is clear from all of the foregoing that independent claims 1, 19, 26, and 27 are in condition for allowance. Dependent claims 2-18, 20-25, and 28-42 depend from and further limit independent claims 1, 19, and 27 and therefore are allowable as well.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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